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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,189	07/24/2001	Steven N. Terranova	2400-171A	8221

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EXAMINER
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BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 03/24/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/912,189

Applicant(s)

TERRANOVA, STEVEN N.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-10, 13-28 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13-28, 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/2/04 has been entered.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive.

The examiner respectfully traverses applicant arguments that **“Randelman does not implement limitations or guidelines that prevent carrying out of the transaction”** (page 8, 2<sup>nd</sup> paragraph). In this case, Randelman teaches of validating and invalidating a transaction by the customer {col. 4, lines 40-55} such as fuel filling, purchasing products {col. 1, lines 6-24; paragraph bridging cols. 1 and 2}. Obviously, if a customer wishes to purchase fuel but is not an authorized operator (invalid transaction), then fuel will not be provided to the customer (the transaction is prevented from being carried out) {FIG. 3, step 34}. For these reason, rejection to the claims is maintained in this Office action.

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***Claim Objections***

3. Objections to the claims in the last Office action are withdrawn.

***Priority***

4. (Resend) Applicant is requested to update the status of the parent application cited in the first sentence of the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-3, 6-10, 13-26 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al).

Regarding claims 1-3 and 9-10, Randelman et al teach a system for providing transaction parameters in association with a remote communication unit {see whole document} which comprises a wireless communication electronics (figures 1 and 2) adapted to receive signals including indicia/vehicle identity from remote communication units (8) {col. 2, lines 16-29}; a transaction interface to carry out transactions {col. 4, lines 19-25; col. 7, lines 21-31}; a control system and memory associated with said communication electronics and said transaction interface {col. 3, lines 13-29}; and said control system adapted to receive the indicia from a remote communication unit and control a transaction at the transaction interface involving the remote communication unit according to predefined parameters defining a limitation or guideline for the transaction associated with the remote communication unit {col. 1, line 26-col. 2, line 2; col. 4, lines 19-65; col. 6, lines 3-6; col. 7, lines 46-52}. Validating and/or invalidating a transaction (controlling a transaction) based on customer preferences (according to predefined parameters defining a limitation or guideline for the transaction) {col. 4, lines 40-55} stored in the card (associated with the remote communication unit) {col. 6, lines 3-6} and sent to the transaction interface {col. 4, lines 14-25; col. 7, lines 21-32};

Randelman does not disclose expressly "said control system will not further carryout the transaction if the transaction does not conform to the transaction guideline or limitation". However, Randelman teaches of validating and invalidating a transaction by the customer {col. 4, lines 40-55} such as fuel filling, purchasing products {col. 1, lines 6-24; paragraph bridging cols. 1 and 2}. Obviously, if a customer wishes to purchase fuel but is not an authorized operator, then fuel will not be provided to the

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customer {FIG. 3, step 34}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a control system that will not carryout a transaction if the transaction does not conform to the transaction guideline or limitation in the system of Randelman, as claimed, because if a customer wishes to purchase fuel but is not an authorized operator, then fuel will not be provided to the customer.

With regards to claims 6-8, although Randelman does not disclose expressly "the predefined parameters limit a transaction to a purchase amount and control a transaction by preventing purchase of select product", these claim limitations would have been obvious in the system of Randelman, to one of ordinary skill in the art {col. 4, lines 19-59; col. 7, lines 32-52}. The remote communication units (8) are cross checked for credit or other billing information as soon as it is determined that the remote communication unit is a valid customer {col. 4, lines 40-42}. The remote communication units provide accounting record containing all data needed for billing, discounts, and **authorized purchases or products** {col. 5, lines 62-65}. Clearly, this implies that the control system can limit a transaction to a purchase amount (**authorized purchases**) and/or control a transaction by preventing purchase of select products (**authorized products**). Limiting a purchase or product is provided in the CPF which stores customer preferred product choices, service appointment times, accounting, or payment methods {col. 6, lines 6-8}. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to "limit a transaction to a purchase amount

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and control a transaction by preventing purchase of select product" as claimed, in the system of Randelman, as described above, to one of ordinary skill in the art.

In claims 13, 14, 15, the system of claim 1 wherein said control system is connected to a network having said memory containing the predefined parameters {col. 5, lines 18-29}.

In claims 16-19, the system of claim 1 further comprising means for alerting a customer of a predefined parameter associated with said control system; wherein said control system is adapted cause said means to alert the customer when a predefined parameter is reached during a transaction; wherein said control system is adapted to cause said means to alert the customer that a predefined parameter exists; wherein said control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the customer of an action violating the predefined parameters {col. 4, lines 60-65; paragraph bridging cols. 5 and 6}.

In claims 20-24, the system of claim 1 further comprising means for alerting an operator of a predefined parameter associated with said control system; wherein said control system is adapted to cause said means to alert the operator when a predefined parameter is reached during a transaction; wherein said control system is adapted cause said means to alert the operator that a predefined parameter exists; wherein said

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control system is adapted to monitor a transaction for actions violating the predefined parameters and cause said means to alert the operator of an action violating the predefined parameters {col. 4, lines 14-19 and lines 44-51; col. 5, lines 18-29}

In claims 25-26, said means is display {col. 7, lines 21-32}.

Claims 34-36 are directed to a method for enforcing the system of claim 1 and its independent claims and therefore rejected for the same reasons.

8. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,072,380 (Randelman et al) in view of US 5,798,931 (Kaehler).

In claims 27-28, Randelman does not disclose said means is an audio system and speaker. These claim limitations are conventional and widely used in gas stations. Most if not all gas stations that are open 24 hours use audio system and speaker to communicate with their customers, especially at night, for fear of theft/hold-up wherein the doors are locked, with just the attendant inside the store. Clearly, having an audio system and speaker in the system of Randelman is beneficial in avoiding theft/holdup. An example of such a system would be the operator intercom system of Kaehler. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have an audio system and speaker in the system of Randelman because this provides deterrence to theft or holdup.



***Examiner Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

March 18, 2004

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

